

TME-2217 - Application No. 10/538,168
Response to Office action January 20, 2010
Response submitted March 10, 2010

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1, 4, and 20 remain in the application. Claims 1 and 20 have been amended. Claims 2, 3, and 5-19 were previously cancelled.

Applicants fully agree with the interview summary by the Examiner dated March 1, 2010.

In item 3 on page 2 of the above-identified Office action, claims 1, 4, and 20 have been rejected as failing to comply with the written description requirement under 35 U.S.C. § 112.

As seen from the Examiner's Interview Summary dated March 1, 2010 the Examiner correctly indicated that the above-noted rejection of claims 1, 4, and 20 should be withdrawn. Therefore, the claims have not been amended to overcome the rejection.

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In item 3 on page 2 of the above-identified Office action, claims 1, 4, and 20 have been rejected as being indefinite under 35 U.S.C. § 112.

The Examiner alleges that there is insufficient antecedent basis for the limitation "said chamber" and the limitation "other chamber" in claim 1 and 20.

It is respectfully noted that the Examiner is in error. Specifically, claim 1 recites a package having a chamber formed therein. Therefore, there is antecedent basis for "said chamber". Accordingly, the Examiner's allegation with respect to said chamber, is in error.

With respect to the limitation "other chamber" the remarks from the previous response are still fully valid and are incorporated herein by reference in their entirety. Moreover, as indicated in the previous response, the Examiner's supervisor had indicated that claim language of "said other chamber" was acceptable and did not require any amendment. However, the Examiner has indicated that the Examiner's supervisor (Ehud Gartenberg) does not recall making such an agreement. Nevertheless, in order to facilitate prosecution of the application claims 1 and 20 have been amended to replace "another" and "other" with the term "second". The

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amendment does not change the scope of the claim at all.

Therefore, because the amendment does not change the scope of the claims and because the Examiner's supervisor had previously indicated that the claim language was acceptable, it is kindly requested that the Examiner enter the after-final amendment.

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for cosmetic or clarificatory reasons. The changes are not provided for overcoming the prior art nor for any reason related to the statutory requirements for a patent.

In item 11 on page 3 of the Office action, claims 1 and 20 have been rejected as being fully anticipated by Hermelin et al. (U.S. Patent No. 6,375,956) (hereinafter "Hermelin") under 35 U.S.C. § 102.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and

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the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

the package having a second chamber formed therein, the second chamber being separate from the chamber and disposed within the chamber, and the second chamber containing a lubricant therein.

It is noted that the remarks with respect to the Hermelin reference from the previous response are still fully valid and are incorporated herein by reference in their entirety.

On page 3 of the Office action in the Examiner indicated that the limitation of "said other chamber being separate from said chamber and disposed within said chamber", was omitted from being considered because the Examiner alleges that "the chambers cannot be separated and at the same time one chamber disposed within the other."

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It is respectfully noted that the Examiner is in error.

Specifically, as seen from the above given remarks, the new matter rejection was improper. Moreover, a chamber disposed within a further chamber can most definitely be separate from the further chamber. This is because boundary defining the chamber would in fact separate it from the further chamber. Therefore, it is respectfully noted that the Examiner's allegation with respect to chambers, is not correct.

The reference does not show the package having a second chamber formed therein, the second chamber being separate from the chamber and disposed within the chamber, and the second chamber containing a lubricant therein, as recited in claim 1 of the instant application. Hermelin discloses a strip pack having separate recesses formed therein. Hermelin does not disclose that recesses are disposed within other recesses. This is contrary to the present invention as claimed, which recites that the package has a second chamber formed therein, the second chamber is separate from the chamber and disposed within the chamber, and the second chamber contains a lubricant therein.

In item 12 on page 4 of the Office action, claim 4 has been rejected as being obvious over Hermelin (U.S. Patent No. 6,375,956) in view of Davidowitz (U.S. Patent No. 3,712,300)

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under 35 U.S.C. § 102. Davidowitz does not make up for the deficiencies of Hermelin. Since claim 1 is allowable, dependent claim 4 is allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1, 4, and 20 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner
Greenberg Stemer LLP, No. 12-1099.

Respectfully submitted,

/Alfred K. Dassler/

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